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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/678,613	10/03/2003	Jamie Garroch	NEC P15578	9435
27667	7590	02/21/2006	EXAMINER	
HAYES, SOLOWAY P.C. 3450 E. SUNRISE DRIVE, SUITE 140 TUCSON, AZ 85718			SANTIAGO CORDERO, MARIVELISSE	
			ART UNIT	PAPER NUMBER
			2687	

DATE MAILED: 02/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/678,613

Applicant(s)

GARROCH, JAMIE

Examiner

Marivelisse Santiago-Cordero

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5, 8 and 9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 8 and 9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 1-5 and 8-9 are pending.

#### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/27/2005 has been entered.

#### ***Response to Arguments***

3. Applicant's arguments with respect to claims 1-5 and 8-9 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Claim Objections***

4. Claims 1-5 and 8-9 are objected to because of the following informalities: the term "an user" (Claim 1, line 3) should be replaced with --a user--.
5. Claim 9 is objected to because of the following informalities: the term "the selection button" should be replaced with --a selection button--, since there is no "selection button" earlier mentioned. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-5 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishihara et al. (hereinafter "Ishihara"; JP 2002077357A; also see Electronic Translation) in view of Karkkainen et al. (hereinafter "Karkkainen"; Patent No.: 6,600,936; cited in form PTO-892, paper no. 20050928).

Regarding claim 1, Ishihara discloses a portable electronic device (Abstract) comprising a display on a front face of the device (Abstract; Fig. 7, reference 33; Fig. 10, reference 71) on which selectable functions may be displayed (Abstract; Figs. 5, 8, 16; paragraph [0058]), highlighted (Figs. 5 and 16; paragraph [0058]), and selected by a user (Abstract), and a touch pad provided on a rear face of the device for a user to select the functions (Abstract; Figs. 1, 6, 8-9, and 11, references 37 and 72), said device further comprising a separate keypad (Figs. 10-11, reference 76) hingedly coupled to the front face of the device (Figs. 10-11, reference 79).

Ishihara fails to disclose a selection bar to indicate which function is presently highlighted and available for selection.

However, Karkkainen discloses a portable electronic device comprising a display on a front face of the device (Fig. 1) on which selectable functions may be displayed (Fig. 1), highlighted (col. 2, lines 30-36), and selected by a user (col. 5, lines 16-19), and a selection bar to indicate which function is presently highlighted and available for selection (Figs. 5-7, reference F).

Therefore, it would have been obvious to one of ordinary skill in this art at the time of invention by applicant to indicate the function presently highlighted and available for selection of Ishihara by a selection bar as suggested by Karkkainen.

One of ordinary skill in this art would have been motivated to indicate the function presently highlighted and available for selection by a selection bar because additional information is provided for the user, in case he/she does not know the meaning of icons very well and to enable a quicker understanding of the selected menu items (Karkkainen: col. 3, lines 57-62), thus, user-friendlier.

Regarding claim 2, in the obvious combination, Ishihara discloses in which the touch pad is positioned substantially directly behind the display (Figs. 10-11).

Regarding claim 3, in the obvious combination, Ishihara discloses in which a cursor is presented on the display (paragraph [0050]) and is controlled by the user during the touch pad (paragraph [0050]).

Regarding claim 4, in the obvious combination, Ishihara discloses in which the function, which is available for selection, is highlighted (paragraph [0058]).

Regarding claim 5, in the obvious combination, Ishihara discloses in which the touch pad has the same dimensions as the display (Figs. 10-11; paragraph [0063]).

Regarding claim 8, in the obvious combination, Ishihara discloses and further including software-controlled circuitry (Fig. 4; paragraphs [0044]-[0051]), which translates a point of contact on the touch pad to a corresponding portion on the display (paragraphs [0044]-[0051]).

8. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ishihara in combination with Karkkainen as applied to claim 1 above, and further in view of Chia-Ying et al. (hereinafter "Chia-Ying"; Patent No.: 5,717,431; cited in form PTO-892, paper no. 20050928).

Regarding claim 9, Ishihara in combination with Karkkainen discloses a selection button (Karkkainen: Fig. 1, reference 5), which would have been obvious to one of ordinary skill in this

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art at the time the invention was made to incorporate, the motivation being for entering a respective menu item or function (Karkkainen: col. 5, lines 10-11). Moreover, Ishihara in combination with Karkkainen discloses in which said device is a hand-held device (Ishihara: Fig. 7). Ishihara in combination with Karkkainen fails to disclose in which the selection button also allows a user to execute 'click' and 'drag-lock' operations.

However, Chia-Ying discloses a portable electronic device in which a selection button also allows a user to execute 'click' and 'drag-lock' operations (col. 6, lines 49-57).

Therefore, it would have been obvious to one of ordinary skill in this art at the time of invention by applicant to execute in the selection button of Ishihara in combination with Karkkainen 'click' and 'drag-lock' operations as suggested by Chia-Ying.

One of ordinary skill in this art would have been motivated to execute in the selection button 'click' and 'drag-lock' operations because it would allow the user to arrange and/or sort the selection based on user's preferences, thus, user-friendlier.

### *Conclusion*

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Pirkola et al. (Patent No.: 6,965,783), Armstrong et al. (Patent No.: 5,729,279), Ishigami (Patent No.: 6,944,472), and Liebenow et al. (Patent No.: 6,909,424) disclose portable hand-held electronic devices having a display on a front face and a touch pad in a rear face.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marivelisse Santiago-Cordero whose telephone number is (571) 272-7839. The examiner can normally be reached on Monday through Friday from 7:30am to 4:00pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lester Kincaid can be reached on (571) 272-7922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MSC 1/28/06

MSC



**LESTER G. KINCAID**  
**SUPERVISORY PRIMARY EXAMINER**